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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,257	05/03/2006	Volker Albrecht	710.1035	7709
23280	7590	04/21/2009	EXAMINER	
Davidson, Davidson & Kappel, LLC 485 7th Avenue 14th Floor New York, NY 10018				COSIMANO, EDWARD R
2863		ART UNIT		PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/564,257	ALBRECHT ET AL.	
	Examiner	Art Unit	
	Edward R. Cosimano	2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 February 2009.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 23-28,31-36 and 38-57 is/are pending in the application.
 4a) Of the above claim(s) none is/are withdrawn from consideration.
 5) Claim(s) 23-28,31-36 and 48-57 is/are allowed.
 6) Claim(s) 38-47 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 10 January 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____ . |

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1. When preparing this Office action the examiner considers the instant application to include:

- A) the Oath/Declaration filed on 03 May 2006 which is acceptable to the examiner;
- B) the Abstract filed on 10 January 2006 which is acceptable to the examiner;
- C) figures 1, 2, 3, 4 & 5 of the set of drawings containing 5 sheets of 5 figures comprising figures 1, 2, 3, 4 & 5 as presented in the set of drawings filed on 10 January 2006 where figures 1, 2, 3, 4 & 5 of the above set of drawings are acceptable to the examiner;
- D) the written description as filed on 10 January 2006 and amended on 10 January 2006 and further amended on 16 July 2008; and
- E) the set of claims as filed on 23 February 2009.

2. Applicant's claim for the benefit of an earlier filing date pursuant to 35 U.S.C. 120, 35 U.S.C. 365(c) and 35 U.S.C. 371 are acknowledged.

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.1 Claims 38-47 are rejected under 35 U.S.C. 101 because the claimed invention is inoperative to achieve a substantial and credible utility and hence is directed to non-statutory subject matter.

4.1.1 It is noted that as one of ordinary skill at the time the invention was made would fairly and reasonably interpret the invention of:

- A) claims 38-47 to be directed to a manufacture/article/item that is defined by it's characteristics/features/components that when taken as a whole defines the manufacture/article/item with a disclosed utility of predicting the mean time between failures of the maintenance intensive critical components or subcomponents of a monitored machine/process; and

B) claim 38-47 to be directed to a storage device/media containing “program” or “code” or “instructions” per se as set forth by applicant as the claimed invention and hence the claimed invention recites a article/manufacture that is intended to perform the one or more recited functions that have been positively recited for program/code/instructions that is stored/contained on the storage device/medium with out a positive recitation of any structure that one of ordinary skill at the time the invention was made would fairly and reasonably recognize as being capable of achieving the any of the positively recited functions of the claimed invention and hence the invention recited as the claimed invention when taken as a whole does not define either a process or machine, see MPEP 2106, 2106.01 & 2106.02, and In re CHATFIELD, 191 USPQ 730 @ 736 (CCPA 1976), or a machine, see In re ALAPPAT, 31 USPQ2d 1545 at 1558 (CAFC 1994).

4.1.2 It is further noted that as one of ordinary skill at the time the invention was made would fairly and reasonably interpret the invention of:

A) claims 38-47 when taken as a whole as being directed to a manufacture/article/item that is intended to achieve the claimed substantial and credible utility of predicting the mean time between failures of the maintenance intensive critical components or subcomponents of a monitored machine/process; and

B) claims 38-47 when taken as a whole as being directed to a “program” or “code” or “instructions” per se stored on a “computer readable storage media” as a process/machine/manufacture that by itself can not achieve the claimed substantial and credible utility of predicting the mean time between failures of the maintenance intensive critical components or subcomponents of a monitored machine/process since as one of ordinary skill at the time the invention was made would recognize the claimed invention fails to positively recite the structure that one of ordinary skill at the time the invention was made would fairly and reasonably recognize as being necessary in order to operatively, usefully and beneficially implement the functions of the recited “program” or “code” or “instructions” so as to achieve the disclosed and recited utility of the claimed invention.

4.1.3 In regard to the invention as recited in the pending claims and when taking each claim as a whole and interpreting the claims, one of ordinary skill at the time of the invention would make the following fair and reasonable observations in regard each of the limitations of the claims, that:

A) claims 38-47 recites an intended utility of predicting the mean time between failures of the maintenance intensive critical components or subcomponents of a monitored machine/process for the “program for” or “code for” or “instructions for” that are stored as non-functional descriptive material on/in “a computer readable media” or “a recording media”, see above, and has been recited as a manufacture/article in claims 38-47 that is intended to perform the substantial and credible functions necessary in order to achieve the of utility of predicting the mean time between failures of the maintenance intensive critical components or subcomponents of a monitored machine/process;

B) the invention as recited in claims 38-47 is intended to perform the one or more recited functions for the stored “program for” or “code for” or “instructions for” that has been stored on/in “a computer readable media” or “a recording media” that has been recited as the claimed invention in order to achieve the desired intended substantial and credible utility of the disclosed and claimed invention, however the claimed invention as recited, would be fairly and reasonably interpreted by one of ordinary skill at the time the invention was made as clearly failing to positively recite any type of structure or limitation that would be fairly and reasonably be recognized by one of ordinary skill at the time the invention was made as requiring that the operation of any machine/process is to be affected in anyway by the functions of the stored “program for” or “code for” or “instructions for” that has recited as the claimed invention in order to achieve the desired intended substantial and credible utility of the disclosed and claimed invention;

C) the body of claims 38-47, recites the claimed invention:

(1) that merely comprises either a “software program” or “code” or “instructions” as a “manufacture/article” that merely stores the recited program of code or instructions for performing the one or more intended functions for the claimed invention that one of ordinary skill at the time the invention was made would fairly and reasonable recognize as being associated with the functions that

would be required in order to achieve the substantial and credible utility of the disclosed and claimed invention; and

(2) that clearly fails to positively recite a requirement that either (a) the operation of a specific machine to be affected in any specific manner when recited “program” or “codes” or “instructions” that have been stored with in the claimed storage media is required to be executed by the machine in order to produce a new machine, see In re ALAPPAT, 31 USPQ2d 1545 at 1558 (CAFC 1994), or (b) the process of operating a machine in order to perform the recited functions of the “program” or “code” or “instructions” is required to be changed, see In re CHATFIELD, 191 USPQ 730 @ 736 (CCPA 1976), and

D) neither (1) the data/information that represents either the “computer program for” or “code for” or “instructions for”; nor (2) the computer readable media or memory device or recording media alone, that applicant has recited as the claimed invention, would be fairly and reasonably recognized by one of ordinary skill at the time the invention was made as being required in order to be usefully and beneficially be operative so as to produce a concretely and tangibly result that would be recognized by one of ordinary skill at the time the invention was made as being required for the actual claimed invention to achieved the recited functionality of the disclosed and claimed invention.

Hence, as one of ordinary skill at the time the invention was made would fairly and reasonably recognize that the language used by applicant in order to define the claimed invention merely recites nothing more than the intended functions of the program or code or instructions or data/information is intended to accomplish but fails to recite any positive limitation that would be fairly and reasonably interpreted by one of ordinary skill at the time the invention was made as a positive recitation that would in fact permit the functionality of the recited program or code or instructions or data/information stored on the computer readable media or memory device or recording media to produce a concrete and tangible result that would be associated with achieving the substantial and credible utility of the disclosed and claimed invention. Therefore, one of ordinary skill at the time the invention was made would recognize that the positively recited functions for the “code” or “program” or “instructions” are in fact non-functional

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descriptive material/data/information upon which patentability can not be based, "Cf. In re GULACK, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are: ... - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material." MPEP 2106, 2106.01 & 2106.02.

4.1.3.1 As a final note in this regard the claimed invention positively recites that the "computer program for" or "code for" or "instructions for" or "commands for" are "adapted to be executed to implemented", that is "may be execute" or "optionally executed" and hence are merely intended to cause a computer to perform the functions recited as the disclosed and claimed invention. However, since a computer is not positively recited as being required to execute or is required to be under the control of the "computer program for" or "code for" or "instructions for" or "command for" recited as the claimed invention, then this language is deemed to be an optional non-functional recitation of a non-limiting intended field of use that may not limit the scope or meaning of the claimed invention.

4.1.4 In view of the above characterization of claims 38-47, it can clearly be seen that, the claimed invention would fairly and reasonably be interpreted by one of ordinary skill at the time the invention was made, as merely conveying to one of ordinary skill at the time the invention was made a description of an invention that merely sets forth the concept of a manufacture/article comprising non-functional data/information stored/recoded that has been store in/on the manufacture/article as a program or code or instructions, where the recited memory/manufacture/article alone, that is by itself, would be fairly and reasonably recognized by

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one of ordinary skill at the time the invention was made as being incapable of realizing the disclosed and claimed credible and substantial utility as set forth by applicant.

4.1.5 Such a claimed invention would be recognized by one of ordinary skill at the time the invention was made, as describing a claimed invention that is not operative to achieve the disclosed and claimed credible and substantial utility as set forth by applicant and that has been held by the court to be non-statutory subject matter, see In re SARKAR, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978).

5. Response to applicant's arguments.

5.1 The objections and rejection that have not been repeated here in have been over come by applicant's last response.

6. The following is a statement of reasons for the indication of allowable subject matter over the prior art:

A) the prior art, for example:

(1) Anderson (2,883,255) discloses a machine/process that provides the useful and beneficial function of a remote machine/process monitoring and logging machine/process in which a sufficient number of machine/process operating parameters to characterize the operation of the monitored machine/process are monitored. The monitored operating parameters are then compared to corresponding thresholds or setpoints in order to determine if the current operation of the monitored machine/process has deviated from the normal operation of the monitored machine/process. When it is determined that the current operation of the monitored machine/process has deviated, then the operating parameter data/information is remotely displayed to an user/operator in a manner that permits the easy identification of the abnormal operating parameters by the user/operator.

(2) Bellows et al (5,132,920) discloses a machine/process that provides the useful and beneficial function of prioritizing the repair of a machine/process by using a determination of the severity of a failure of a machine/process as determined from the reciprocal of the mean time to failure of each of the failed components of the machine/process.

(3) Hooks et al (6,532,426) discloses a machine/process that provides the useful and beneficial function of using an evaluation or analysis of different operating scenarios during the process of designing machines/process in which the effective mean time to failure of a machine/process is determined based on an adjustment of the mean time to failure of each of the components of the machine/process with a consideration for available spare parts/components.

(4) Brand et al (7,149,673) discloses a machine/process that provides the useful and beneficial function of estimating the changes in the life of a machine/process/product in order to redesign the machine/process/product by considering the inverse of a mean time between failures of the machine/process/product.

B) however, the prior art does not fairly teach or suggest in regard to claims 23, 38 & 48 a process in claim 23, an article or manufacture in claim 38 and as a machine in claim 48, that provides the useful and beneficial function of determining the mean time between failures of a machine/component by providing actions in claim 23 and structures in claims 38 & 48 that perform at least the functions of:

(1) determining or acquiring a setpoint for the mean time between failures (MTBF) value for each of the critical components of a machine/process, that when a critical component fails then the machine/process will fail;

(2) determining or calculating a summation of the inverse or reciprocal of the values of the setpoint MTBF values for each of the critical components of the machine/process; and

(3) determining or calculating a predicted MTBF value as the inverse or reciprocal of the determined summation of the inverse or reciprocal values for the setpoint MTBF values for each of the critical components of the machine/process.

Claims 24-28 & 31-36, which depend from claim 23, claims 39-47, which depend from claim 38, and claims 49-57, which depend from claim 48, are allowable over the prior art for the same reason.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward R. Cosimano whose telephone number is 571-272-0571.

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The examiner can normally be reached on 571-272-0571 from 7:30am to 4:00pm (Eastern Time).

7.1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7.2 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERC
04/20/2009

**/Edward Cosimano/
Primary Examiner Unit 2863**